

U.S.S.N. 09/975,672
Filed: October 10, 2001
AMENDMENT &
RESPONSE TO OFFICE ACTION

Remarks

Upon entry of the foregoing amendment, claims 26-39, 43, 52, and 56-61 are pending in the application. Applicants note that the Office Action did not address previously added claim 61 and erroneously indicates that claim 52 (sic 51) is withdrawn.

Amendments

Claims 1-25, 51, and 53-55 have been canceled without prejudice, as being drawn to a non-elected invention.

Claims 26 and 56 have been amended to specify that the telemetry system transmits data *from* the implantable medical device *to* the remote controller. Claim 61, which depends from claim 56, was amended to delete this same limitation. Support for these amendments is found throughout the specification, including FIG. 1; page 12, lines 13-18; page 14, line 29 to page 15, line 1. **The amendments should be entered because they add only a limitation that previously was present in a dependent claim that should have been considered. The amendment therefore should not require a new search and consideration.**

Rejections Under 35 U.S.C. § 102

Claims 26-39, 43, 41, and 56-60 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 5,989,445 to Wise et al. (hereinafter "Wise"). Claims 26-39, 43, 41, and 56-60 also were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent 5,797,898 to Santini et al. or U.S. Patent 6,123,861 to Santini et al. (hereinafter, collectively, "the Santini Patents"). Claims 26-39, 43, 41, and 56-60 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,730,072 to Shawgo et al. (hereinafter "Shawgo"). Claims 26-39, 43, 41, and 56-60 also were

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rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,908,770 to McDevitt et al. (hereinafter "McDevitt"). Applicants respectfully traverse these rejections.

Wise

Wise discloses a microchannel nozzle. Wise fails to a device having a telemetry system for the wireless transfer of data between the medical device and a remote controller, as required by Applicants' claims 26-39, 43, 52, and 56-61. Wise also fails to disclose a device in which the reservoir has a reservoir cap positioned on the reservoir over the reservoir contents, wherein release or exposure of the reservoir contents is controlled by disintegration of the reservoir cap, as required by Applicants' claims 36 and 56-61. Furthermore, Wise fails to disclose a device having reservoirs that contain an immobilized enzyme, as required by Applicants' claims 52 and 58. The rejection over Wise is clearly baseless and should be withdrawn.

The Santini Patents

The Santini Patents disclose a multi-reservoir device for containing chemical molecules and methods of fabrication thereof. The Santini Patents disclose "activation of a particular reservoir by the application of an electric potential can be controlled externally by remote control." Santini '898, Col. 10, Lines 61-63. This remote activation embodiment is further illustrated by FIG. 3. (Note the one-way direction of the arrow from the source of input, e.g., signal receiver, to the microprocessor.) However, nothing in the Santini Patents discloses or suggests a telemetry system for the wireless transfer of data between the microchip device and a remote controller, wherein the telemetry system transmits data from the microchip device to the remote controller, as required by Applicants' claims. The Santini Patents simply do not teach such bi-directional data transfer, as now claimed. The rejection therefore should be withdrawn.

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Shawgo

Shawgo issued from U.S. Application 09/867,976 filed May 30, 2001. It claims priority to U.S. Provisional Application 60/207,814 filed May 30, 2000 ("the Shawgo Provisional"). The present application claims priority to Provisional Application 60/239,222 filed October 10, 2000, which is prior to all new matter that added to the Shawgo Provisional and appeared in the later filed Application 09/867,976. Therefore, Shawgo is facially available as prior art, if at all, *only for that information that was disclosed in the Shawgo Provisional.*

The Shawgo Provisional, however, fails to disclose a telemetry system for the wireless transfer of data between the microchip device and a remote controller, wherein the telemetry system transmits data from the microchip device to the remote controller, as required by Applicants' claims. Therefore, Applicants claims are novel over Shawgo, and the rejection should be withdrawn.

McDevitt

McDevitt discloses a sensor array having cavities containing reagent beads, wherein the cavities are covered by a window elevated to permit an analyte fluid to flow into the cavities. A light source transmits light through the window and cavities. A light detector on the other side of the array detects color changes indicative of a reaction between the analyte and reagent.

McDevitt fails, however, to disclose a telemetry system for the wireless transfer of data between the microchip device and a remote controller, wherein the telemetry system transmits data from the microchip device to the remote controller, as required by Applicants' claims. The light transmission and detection used by McDevitt to interrogate the state of his sensor array is not telemetry. Rather, it is photometry, since the detector is simply measuring the intensity of

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the light that passes through the sensor. In contrast, the light or electromagnetic wave in a telemetry system serves as a carrier of the signal being transmitted. The data is encoded at the transmitter by modulating the amplitude (AM) or frequency (FM) of the carrier, and decoded at the receiver. This concept clearly is not taught by McDevitt.

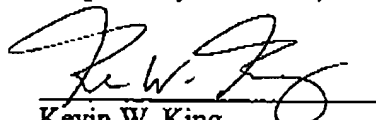
Furthermore, McDevitt clearly fails to disclose a device in which the reservoir has a reservoir cap positioned on the reservoir over the reservoir contents, *wherein release or exposure of the reservoir contents is controlled by disintegration of the reservoir cap*, as required by Applicants' claims 36 and 56-61.

Conclusions

For the foregoing reasons, Applicants submit that the claims as amended are novel and patentable over the prior art of record. Allowance of claims 26-39, 43, 52, and 56-61 is therefore earnestly solicited.

The undersigned respectfully invites the Examiner to contact him by telephone (404.853.8068) if any outstanding issues can be resolved by conference or examiner's amendment.

Respectfully submitted,


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Date: September 29, 2005
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